



PATENT
Customer No. 22,852
Attorney Docket No. 05725.1010-00

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:)	
)	
Gilles RUBINSTENN et al.)	Group Art Unit: 2624
)	
Application No.: 10/024,615)	Examiner: John B. Strege
)	
Filed: December 21, 2001)	Confirmation No.: 3934
)	
For: ANALYSIS USING A THREE-)	
DIMENSIONAL FACIAL IMAGE)	

Attention: Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Appellants submit this Reply Brief under 37 C.F.R. § 41.41 to the Board of Patent Appeals and Interferences ("the Board"), in response to the August 8, 2007 Examiner's Answer ("Examiner's Answer") in this case.

I. **ARGUMENT**

A. **The Examiner Has Not Established A Prima Facie Case of Obviousness**

Despite the Examiner's assertions to the contrary, the Examiner has not established a prima facie case of obviousness. Rather, for the reasons provided below, the Examiner's attempt to rebut Appellants' arguments highlights this deficiency, as well as demonstrating the shortcomings in the Examiner's obviousness analysis.

In its recent decision in *KSR International Co. v. Teleflex Inc.*, No. 04-1350 (U.S. Apr. 30, 2007), slip op. at 2, the Supreme Court confirmed that the "framework for applying the statutory language of §103" is still based on its landmark decision in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966). Several basic factual inquiries must be made in order to determine the obviousness or non-obviousness of claims of a patent application under 35 U.S.C. § 103. These factual inquiries, set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), require the Examiner to:

- (1) Determine the scope and content of the prior art;
- (2) Ascertain the differences between the prior art and the claims in issue;
- (3) Resolve the level of ordinary skill in the pertinent art; and
- (4) Evaluate evidence of secondary considerations.

The obviousness or non-obviousness of the claimed invention is then evaluated in view of the results of these inquiries. *Graham*, 383 U.S. at 17-18, 148 USPQ 467; *see also KSR Int'l Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007), slip op. at 2.

Thus, in order to satisfy the initial burden of establishing a *prima facie* case of obviousness, the Examiner must first show that the prior art references teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). The

Examiner must also show that there is some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references. *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). In the *KSR* case, the Supreme Court recognized that a showing of “teaching, suggestion, or motivation” could provide helpful insight in determining whether the claimed subject matter is obvious under Section 103(a). *KSR*, slip op. at 14.

Additionally, the Supreme Court mandates that “[t]o facilitate review, this analysis [of whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue] should be made explicit.” *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (Federal Circuit, 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)).

Following the *KSR* decision, the Office issued a memorandum to its technology center directors on May 3, 2007, indicating that **“in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.”** (Emphasis in original).

1. The motivation identified by the Examiner for modifying Nagaishi in view of Furuta is based on the Examiner's mischaracterization of Nagaishi

In the Examiner's Answer, the Examiner asserted that Furuta provides "a motivation to combine [Nagaishi] with Furuta based on the teaching . . . that 3D simulations provide more realistic beauty simulations." Examiner's Answer at 14. Nagaishi, however, has nothing to do with simulations, not to mention beauty simulations. Nagaishi teaches a makeup support method using **image processing**. Nagaishi, paragraph (0001). Rather than simulating beauty products on a facial image to demonstrate how beauty products would look on a person, Nagaishi analyzes a facial image to obtain information related to skin conditions. Nagaishi, paragraph (0013). Because Nagaishi does not use a facial image to simulate how a beauty product would look on a person, "providing more realistic beauty simulations" cannot be the motivation to use a three-dimensional image in the system of Nagaishi.

Furthermore, as the Examiner asserted, "Nagaishi [allegedly discloses] that the system can be composed of two cameras that are installed on both sides and that the images from both cameras can be mixed to get the front face image of the person." Examiner's Answer at 14. However, the system of Nagaishi does not construct a three-dimensional facial image to extract information related to skin conditions. This further demonstrates that there is no motivation to use a three-dimensional image for the purpose of analyzing and extracting information from a facial image.

While Nagaishi has nothing to do with simulations, the Examiner continued to mischaracterize the system of Nagaishi as a two-dimensional beauty simulation system. For example, the Examiner asserted that "[t]here would be a design incentive which

would have prompted one of ordinary skill in the art to adapt [Nagaishi] to make a three-dimensional beauty simulation since it would allow the user to form a more realistic picture of how the makeup would affect them.” Examiner’s Answer at 16. However, the system of Nagaishi uses a facial image to extract information related to skin conditions from the image, and not to simulate how a beauty product would look on a person. Because the system of Nagaishi is not designed and/or intended to provide simulations, one of ordinary skill in the art would not have had any design incentive or other reason to modify the system of Nagaishi to make a three-dimensional beauty simulation.

The Examiner made several arguments with respect to the recent decision in *KSR*. *KSR*, however, does not relieve the Examiner from the duty to establish a prima facie case of obviousness, and the Examiner must still identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed. However, the hindsight reasons identified by the Examiner are, at best, conjectural and based on the Examiner’s mischaracterization of Nagaishi, which is not supported by any findings.

II. Conclusion

For the reasons presented in the Appeal Brief, as well as the reasons outlined above, the Board is kindly requested to reverse all of the outstanding claim rejections, so that pending claims 2-6, 8-17, and 19-44 may be allowed.

To the extent that any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Reply Brief, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: October 4, 2007

By: 

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